

REMARKS

Without conceding that claims 5, 6, 8 and 12-14 fail to comply with the written description requirement, these claims are being canceled without prejudice to the filing of a continuation, only to expedite prosecution of the instant case.

Replacement drawing sheets for Figures 2, 3, 4 and 5 are attached herewith.

Claims 1-4, 9-12, 15, 18 and 21 stand rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,823,230 to Jamalabad et al. However, Applicant disagrees that anticipation has been established, and since claim 1 is the only independent claim, it is argued that all of the dependent claims are allowable as well.

In particular, claim 1 includes the limitation of "identifying regions [of an object to be fabricated] in which at least one automated material addition process and at least one automated material subtraction process should occur ..." (emphasis added). Jamalabad et al. do not teach or suggest such a limitation. Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

In this instance, the Examiner points to column 2, lines 38-41, which discuss "additive manufacturing," and column 2, lines 25-27 which touch on "subtractive machining." However, these passages, in the Background of the Invention, point to entirely different processes, which are independently applied in accordance with disparate methodologies. As set forth in the '230 patent, whereas "an example of subtracting machining nulling," additive manufacturing includes "solid free form manufacturing," an entirely different process. Given that claim 1 includes a step of identifying regions requiring both an addition and subtraction process to occur in order to fabricate the object in accordance with the description, this limitation is not met. Nor are the limitations of generating tool paths associated with the addition and subtraction processes, and fabricating the object in accordance with the tool path, since these tool paths would never be generated according to the prior art, since the

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addition and subtraction processes are independent of one another.

Based upon the foregoing amendment and comments, Applicant believes all pending claims are in condition for allowance. Questions regarding this application may be directed to the undersigned by telephone, facsimile or electronic mail.

Respectfully submitted,

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